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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,214	01/28/2004	Ray Bojarski	00167-524001 / 02-31-0483	7657
7590 Joel R. Petrow, Esq. Chief Patent Counsel Smith & Nephew, Inc. 1450 Brooks Road Memphis, TN 38116				
04/09/2008				
EXAMINER				
WOO, JULLAN W				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
04/09/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,214

Applicant(s)

BOJARSKI ET AL.

Examiner

Julian W. Woo

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-10,12,13 and 15-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-10,12,13 and 15-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/29/07, 11/2/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3, 4, 6, 7-10, 12, 13, 15-17, 19, 22-28, and 30 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to base claims 1, 9, 22, and 30, the specification does not describe or apply the term, "ledge," which may have various definitions or applications within and even outside of the art of the invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3, 4, 6, 7-10, 12, 13, 15-17, 19, 22-28, and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to base claims 1, 22, and 30, it is not certain whether "a member" and "a tube" are structural parts of the invention. With respect to base claim 9, it is not certain whether "a member" is a structural part of the invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 3, 4, 6, 8, 9, 10, 12, 13, 15-17, 19, 22-27, 29, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nelson et al. (4,715,841). Nelson et al. disclose, at least in figures 1-4 and 10, a device including a first portion (22) defining a tapered hole configured for guiding a member into a tube (28) that can be coupled to the body, a guide means, or a first terminal end portion; a second portion (40 and 24 combined or 40 for base claim 9) defining a bore, a receiving means, or a second terminal end portion; a ledge (34) formed on an internal surface of the body at an intersection between the tapered hole and the bore, the body defining a slot (38) communicating with the hole and the bore or a separating means, where the bore has a constant diameter (at 50), where the bore is tapered (at 44), where the slot extends from the tapered hole and the bore to an external surface of the body, where the device includes a handle (30) extending from the body, where the device includes a tube (28 or 24 for base claim 9), where the body is configured for connection to an end of the tube, where the tube (28 or 24) defines an opening for receiving the member, where the width of the tube opening (of 24) is substantially the same as the width of the narrowest portion of the tapered hole, where the slot (38) extends from a terminal end of the first portion to a terminal end of the second portion or from the first terminal end portion to

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the second terminal end portion, and where the device includes a cylindrical handle (30 or 28) connected to the body at a location opposite to the slot.

7. Claims 1, 7, 9, 18, 20, 21, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Mericle et al. (5,423,837). Mericle et al. disclose, at least in figures 2, 4 and 5 and in col. 3, line 15 to col. 4, line 57; a device including a first portion (6) defining a tapered hole configured for guiding a member into a tube (26) that can be coupled to the body, a second portion (14) defining a bore, a ledge (proximal of 30) formed on an internal surface of the body at an intersection between the tapered hole and the bore, the body defining a slot (30) communicating with the hole and the bore, and a tube (26); where the device includes a member that comprises a suture thread ("suture material"). Mericle et al. also disclose, at least in figure 2 and in col. 3, lines 22-53 and col. 4, lines 45-57; a method including coupling a body (6) to an end of a tube (26), the body defining a tapered hole and a slot (30); guiding a member ("suture material") into the tube (for cutting of the suture material at the distal tip of 26) through the tapered hole; and separating the body and the member by passing the member through the slot, where coupling includes receiving the end of the tube in a bore in the body (at the proximal portion of 6 and distal of 14), the bore communicating with the tapered hole, and where the body is decoupled from the end of the tube (when the tube is retracted by spring 18).

Response to Amendment

8. Applicant's arguments with respect to claims 1, 3, 4, 6-10, 12, 13, and 15-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Burns (6,375,534), Heckman (6,449,865), and Nelson et al. (6,575,806) teach devices each with a body including a tapered hole and a slot.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (571) 272-4707. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Julian W. Woo/
Primary Examiner, Art Unit 3773

April 9, 2008